

**REMARKS**

Claims 1, 8, 14-35 and 60-68 were previously cancelled without prejudice. Claims 2-7, 9-13, 36-59, 69-94 remain in the application for consideration. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application.

**35 U.S.C. §§ 102 and 103 Rejections**

Claims 36-40, 43, 46-48, 50-54, 59, 80, 81, 84-89 and 92-94 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,572,648 to Bibayan.

Claims 2, 5-7 and 9-11 stand rejected under 35 U.S.C. § 103(a) as being obvious over Bibayan in view of U.S. Patent No. 6,563,514 to Samar (hereinafter "Samar").

Claims 3, 4 and 13, stand rejected under 35 U.S.C. § 103(a) as being obvious over Bibayan in view of Samar and U.S. Patent No. 5,742,504 to Meyer et al. (hereinafter "Meyer").

Claims 12, 41, 42, 45, 49, 56, 57, 82, 83, 90 and 91 stand rejected under 35 U.S.C. § 103(a) as being obvious over Bibayan in view Meyer.

Claims 44 stands rejected under 35 U.S.C. § 103(a) as being obvious over Bibayan in view of U.S. Patent No. 6,611,840 to Baer et al. (hereinafter "Baer").

Claim 55 stand rejected under 35 U.S.C. § 103(a) as being obvious over Bibayan and U.S. Patent No. 5/436,637 to Gayraud et al. (hereinafter "Gayraud").

Claim 58 stands rejected under 35 U.S.C. § 103(a) as being obvious over Bibayan in view of U.S. Patent No. 5,602,996 to Powers III et al. (hereinafter "Powers").

1           Claims 69-79 stand rejected under 35 U.S.C. § 103(a) as being obvious  
 2 over Baer in view of Meyer.

3           Before undertaking a discussion regarding the substance of the Office's  
 4 rejections, the following discussion of the § 103 Standard is provided.

5

6           The § 103 Standard

7           To establish a prima facie case of obviousness, *three basic criteria must be*  
 8 *met*. First, there must be some suggestion or motivation, either in the references  
 9 themselves or in the knowledge generally available to one of ordinary skill in the  
 10 art, to modify the reference or to combine reference teachings. *In re Jones*, 958  
 11 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5  
 12 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation  
 13 of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.  
 14 1986). Finally, the prior art reference (or references when combined) must teach  
 15 or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580  
 16 (CCPA 1974). The teaching or suggestion to make the claimed combination and  
 17 the reasonable expectation of success *must* both be found in the prior art, not in  
 18 applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1439 (Fed. Cir.  
 19 1991).

20           Hence, when patentability turns on the question of obviousness, the search  
 21 for and analysis of the prior art includes evidence relevant to the finding of  
 22 whether there is a teaching, motivation, or suggestion to select and combine the  
 23 references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin*  
 24 *Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)  
 25 ("the central question is whether there is reason to combine [the] references," a

question of fact drawing on the Graham factors). The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or *the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.*" *Ex parte Clapp*, 227 USPQ 972, 973 (Bd.Pat. App. & Inter. 1985)(emphasis added).

Chapter 2100 of the MPEP provides further instruction as follows: "With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not." See MPEP 2142.

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful

1 attraction of a hindsight-based obviousness analysis is rigorous application of the  
 2 requirement for a showing of the teaching or motivation to combine prior art  
 3 references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.  
 4 Cir. 1998) (there must be some motivation, suggestion, or teaching of the  
 5 desirability of making the specific combination that was made by the applicant); *In*  
 6 *re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings  
 7 of references can be combined only if there is some suggestion or incentive to do  
 8 so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*,  
 9 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)); *In re Fritch*, 23  
 10 USPQ2d 1780, 1784 (Fed. Cir. 1992) ("It is impermissible to use the claimed  
 11 invention as an instruction manual or 'template' to piece together the teachings of  
 12 the prior art so that the claimed invention is rendered obvious. [O]ne cannot use  
 13 hindsight reconstruction to pick and choose among isolated disclosures in the prior  
 14 art to deprecate the claimed invention.") (quoting *In Re Fine*, 837 F.2d 1071,  
 15 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

16 The need for specificity pervades this authority. See, e.g., *In re Kotzab*,  
 17 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular  
 18 findings must be made as to the reason the skilled artisan, with no knowledge of  
 19 the claimed invention, would have selected these components for combination in  
 20 the manner claimed").

21 **Claims Rejected under §§ 102 and 103**

22 **Claim 6** recites a method of exposing commands in a software application  
 23 program comprising [emphasis added]:

24  
 25

- 1     • *determining a user's context within an application program by ascertaining a position of a user's cursor within a document* provided by the application program; and
- 2     • automatically displaying at least one command on a display for the user based on the user's context.
- 3

4                 In making out the rejection of this claim, the Office argues that the  
5 combination of Bibayan and Samar disclose the subject matter of this claim.  
6 Specifically, the Office cites column 4, lines 45-65, of Bibayan and argues that it  
7 discloses that the dynamic tool palette display alters its size, shape, and contents in  
8 accordance with the context of the currently operating applet. The Office then  
9 cites column 4, lines 40-44, of Bibayan and states that while it teaches "the user  
10 locating and initiating a command", it does not teach "the position of the cursor  
11 alone determining the user context." The Office then refers to Samar and argues  
12 that column 4, lines 39-45, column 9, lines 30-34, and figures 6a and 6b disclose  
13 "a system in which users selection of a particular display cause context evaluation  
14 and further provides and additional display to a user". The Office further argues  
15 that column 4, lines 39-45, of Samar teaches "the point of interest being  
16 determined by a pointer or cursor positioned by a user over the item of interest."  
17 The Office then reasons that it would have been obvious to modify Bibayan with  
18 Samar because "changing the display based on the user's cursor changes the item  
19 of focus without having to make a selection."

20                 Applicant agrees that Bibayan does not teach "the position of the cursor  
21 alone determining the user context." However, Applicant respectfully disagrees  
22 with the Office's obviousness rejection and reminds the Office that there must be  
23 some suggestion or motivation, either in the references themselves or in the  
24 knowledge generally available to one of ordinary skill in the art, to modify the  
25

reference or to combine reference teachings. (*In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); see also MPEP 2143). Here, there is nothing in either of the references that suggests that the motivation to combine the teachings of Samar with Bibayan is known outside of Applicant's disclosure. Applicant respectfully reminds the Office that the examiner bears the burden of explaining "why the combination of the teachings is proper." (MPEP 2142). The Office's only attempt at such an explanation is to state that one would have been motivated because "changing the display based on the user's cursor changes the item of focus without having to make a selection." Applicant submits that, upon close examination, this statement merely describes the apparent advantages of Samar, and fails to explain *why* the combination is proper.

As an aside, the Office has provided a paper, available at the following link:

<http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm>

that describes proper and improper rejections made under §103(a). Particularly instructive is a portion that appears in Section IV of the paper which provides guidance in regards to communicating a proper §103(a) rejection. The pertinent part of this paper is reproduced below for the Office's convenience:

#### IV. Communicating the Rationale for a Proper Rejection under 35 U.S.C. 103

When an examiner rejects a claim as failing to meet one or more of the statutory requirements for patentability, administrative due process and 35 U. S.C. 132 require that applicant be adequately notified of the reasons for the rejection of the claim so that applicant can decide how to proceed. The statutory requirement that

an Office action state the reasons for any rejection is critical to proper action taking.

In writing a rejection under 35 U.S.C. 103, the examiner should appropriately communicate:

- (1) the particular part of a reference being relied upon should be designated as nearly as practicable; 37 CFR § 1.104(c)(2);
- (2) the differences between the claimed invention and the closest prior art;
- (3) where the differences are found or suggested in the prior art;
- (4) how the teachings of the prior art are combined; and
- (5) *why the combination of those teachings would have been obvious to one of ordinary skill in the art at the time the invention was made. Do not recite the disclosure of the prior art which reads on the claimed invention as the motivation. Communicate why the references themselves, the knowledge of one of ordinary skill in the art, or the nature of the problem to be solved establishes a motivation to combine the prior art references.*

Once applicant has presented rebuttal evidence, examiners should reconsider any initial obviousness determination in view of the entire record. All the proposed rejections and their bases should be reviewed to confirm their correctness. Only then should any rejection be imposed in an Office action. The Office action should clearly communicate the Office's findings and conclusions, *articulating how the conclusions are supported by the findings.*

Here, as discussed above, the Office's stated motivation merely recites the disclosure of Samar and is unacceptable, as demonstrated by the Office's own guidance given above.

Furthermore, modifying Bibayan with the teachings of Samar would appear to render Bibayan unsatisfactory for its intended purpose. Specifically, Bibayan discloses a "method and apparatus for changing a dynamic tool palette in accordance with a current context *of an application*". (see Abstract). If this "context sensitive display system" was modified, as suggested by the Office, to "adapt based on a cursor position as did Samar", then Bibayan would no longer change a dynamic tool palette in accordance with a current context *of an application*. Applicant respectfully reminds the Office that "[i]f proposed

modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (*In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); see also MPEP 2143.01). Additionally, this proposed modification would change Bibayan's principle of operation because the dynamic tool palette would be changed to "adapt based on a cursor position as did Samar" (as characterized by the Office), rather than "in accordance with a current context *of an application*." Applicant respectfully reminds the Office that "[i]f the proposed modification of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (MPEP 2143.01).

Finally, column 1, lines 9-12 of Samar explains that it "relates to providing supplementary relevant information to the user of a computer on a network *without changing the user's context*." (emphasis added). Thus, Samar appears to teach-away from "determining a user's context within an application", as claimed. Thus, it is hard to imagine any motivation for combining Bibayan with Samar - which teaches away from the subject matter of this claim.

In view of the above discussion, the Office has not established a *prima facie* case of obviousness. Hence, for at least this reason, this claim is allowable.

**Claims 2-5, 7 and 9-11 depend from claim 6 and are allowable as depending from an allowable base claim.** These claims are also allowable for their own recited features which, in combination with those recited in claim 6, are neither disclosed nor suggested in the references of record, either singly or in combination with one another. In addition, given the allowability of claim 6, the

1 rejection of claims 3 and 4 over the combination including Meyer is not seen to  
 2 add anything of significance.

3 **Claim 12** recites one or more computer-readable media having computer-  
 4 readable instructions thereon which, when executed by a computer, cause the  
 5 computer to [emphasis added]:

- 6 • determine a user's context *within an application* program;
- 7 • automatically display, *independent of the user selecting any*  
*displayed menu item*, at least one command on a display for the user  
   based on the user's context, said at least one command being  
   displayed in a modeless fashion in which the user can continue to  
   work within a document provided by the application program while  
   said at least one command is displayed; and
- 8 • automatically remove said at least one command from the user's  
   display responsive to a change in the user's context.

9  
 10  
 11 In making out the rejection of this claim, the Office argues that the  
 12 combination of Bibayan and Meyer disclose the subject matter of this claim.  
 13 Specifically, the Office argues that Bibayan discloses automatically displaying at  
 14 least one command independent of the user selecting any displayed menu item,  
 15 citing to column 4, lines 45-65 for support. Applicant respectfully disagrees and  
 16 traverses the Office's rejection.

17 In the previous response, Applicant explained that the process described by  
 18 this excerpt is initiated by, and thus dependent upon, the user selecting folder icon  
 19 23. (see Fig. 4). As noted in the previous response, the process described in the  
 20 excerpt cited by the Office is dependent upon the user selecting an icon (i.e. "in  
 21 the case the user selects folder icon 23"). Hence, Bibayan does not, as the Office  
 22 contends, disclose or suggest automatically displaying a command independent of  
 23  
 24

1 a user selecting any displayed menu item. In point of fact, Bibayan teaches  
2 directly away therefrom. Accordingly, the Office has not established a *prima facie*  
3 case of obviousness and this claim is allowable.

4 In response to Applicant's argument, the Office argues that the excerpt  
5 discussed above (column 4, lines 45-65) in which the user selects a folder icon  
6 from the static toolbar is merely a "specific example of the invention as claimed."  
7 The Office additionally cites to column 9, lines 30-40, of Bibayan and argues that  
8 "the dynamic tool palette having tool functions specified by 'examining the  
9 specified context environment of the currently executing application program...'"'.  
10 The Office notes that this "is a specific example and that context can be evaluated  
11 from a window not prompted from the static toolbar." Finally, the Office further  
12 cites column 1, lines 55-61, of Bibayan and argues "when one window yields  
13 focus to another this would be a method of changing context."

14 Applicant respectfully submits that the Office has not provided any excerpt  
15 from Bibayan where automatically displaying a command is independent of a user  
16 selecting any displayed menu item. Furthermore, Applicant is confused as to the  
17 relevance of column 9, lines 30-40. This excerpt is part of claim 1 in Bibayan  
18 which recites "launching an application program within the currently-executing  
19 application program...", prior to "examining the specified context environment of  
20 the currently executing application program...". Since the scope of this claim  
21 must be commensurate with the scope of enablement provided by the disclosure  
22 (see MPEP 2164.08), Applicant fails to see how this changes the fact that Bibayan  
23 does not, as the Office contends, disclose or suggest automatically displaying a  
24 command independent of a user selecting any displayed menu item.

Finally, the Office's reliance on column 1, lines 55-61, of Bibayan is misplaced. This excerpt is reproduced below (emphasis added):

*Each applet*, once selected, *operates to open a window* which is brought to the foreground of the display. The window may also be overlapped onto a previously opened window if the previous function has not been "closed out". However, only a window which is "in focus" is the currently operating window until it is closed or temporarily yields focus to another window.

This excerpt indicates that *each applet*, once selected, *opens a window* which is brought to the foreground. Thus, the Office's argument "when one window yields focus to another this would be a method of changing context" is not relevant to this claim because each window is associated with another application. Thus, when one window yields focus to another, context is not changed within the same application. Applicant reminds the Office that this claim recites determining a user's context *within an application* program.

Hence, despite the Office's response, Bibayan does not disclose or suggest determining a user's context within an application program and automatically displaying a command independent of a user selecting any displayed menu item and, in point of fact, teaches directly away therefrom. Accordingly, the Office has not established a *prima facie* case of obviousness and this claim is allowable.

Claim 13 depends from claim 12 and is allowable as depending from an allowable base claim. This claim is also allowable for its own recited features which, in combination with those recited in claim 12, are neither disclosed nor suggested in the references of record, either singly or in combination with one another.

1           **Claim 36 recites a method of exposing commands in a software application**  
2           **program comprising [emphasis added]:**

- 3
- 4         • *determining a user's context within an application* program by  
5           evaluating at least portions of one or more expressions, each  
6           expression being associated with a context block and defining a  
7           condition that describes one or more aspects of a user's interaction  
8           with the application program; and
  - 9         • automatically displaying, *independent of a user selecting any*  
10          *displayed menu item*, at least one context block on a display for the  
11          user based on the user's context, individual context blocks  
12          containing multiple commands that are possible selections for a user  
13          based upon their context.

14

15          In making out the rejection of this claim, the Office argues that Bibayan  
16          anticipates the subject matter of this claim. In the previous response, Applicant  
17          argued that Bibayan does not disclose or suggest displaying a context block  
18          *independent of a user selecting any displayed menu item*, and instead teaches  
19          directly away from any such subject matter. Applicant explained that the  
20          processing described in Bibayan appears to always be set in motion responsive to  
21          a user selecting a *menu item*. Applicant respectfully invited the Office to point to  
22          a specific portion of Bibayan where a context block or command is displayed  
23          independent of a user selecting any displayed menu item. Applicant has reviewed  
24          Bibayan in its entirety and can find no such disclosure.

25

26          In response to Applicant's argument, the Office argues that the excerpt  
27          discussed above (column 4, lines 45-65) in which the user selects a folder icon  
28          from the static toolbar is merely a "specific example of the invention as claimed."  
29          The Office additionally cites to column 9, lines 30-40, of Bibayan and argues that  
30          "the dynamic tool palette having tool functions specified by 'examining the

1 specified context environment of the currently executing application program...”.  
 2 The Office notes that this “is a specific example and that context can be evaluated  
 3 from a window not prompted from the static toolbar.” Finally, the Office further  
 4 cites column 1, lines 55-61, of Bibayan and argues “when one window yields  
 5 focus to another this would be a method of changing context.”

6 As described above, despite the Office’s response, Bibayan does not  
 7 disclose or suggest determining a user’s context within an application program and  
 8 automatically displaying a command independent of a user selecting any displayed  
 9 menu item and, in point of fact, teaches directly away therefrom. Accordingly, the  
 10 Office has not established a *prima facie* case of obviousness and this claim is  
 11 allowable.

12 **Claims 37-45** depend from claim 36 and are allowable as depending from  
 13 an allowable base claim. These claims are also allowable for their own recited  
 14 features which, in combination with those recited in claim 36, are neither disclosed  
 15 nor suggested in the references of record, either singly or in combination with one  
 16 another. In addition, given the allowability of claim 36, the rejections of claims  
 17 41-42 and 45 over the combination with Meyer; and of claim 44 over the  
 18 combination with Baer is not seen to add anything of significance.

19 **Claim 46** recites a method of exposing commands in a software application  
 20 program comprising [emphasis added]:

- 21     • *determining a user’s context within an application program*  
       *without requiring the user to make a menu selection;*
- 22     • based on the user’s context, displaying commands that are associated  
       with the context and which can assist the user in accomplishing a  
       task; and
- 23     • while the commands are being displayed, enabling the user to select  
       and apply various commands multiple times.

In making out the rejection of this claim, the Office argues that its subject matter is anticipated by Bibayan, citing to column 4, lines 45-65 for support. Specifically, the Office argues that the display is dependent on the context of the applet and therefore not on the user selecting any displayed menu item. As Applicant explained in the previous response, *this is simply not the case and constitutes a misinterpretation of the reference.*

In its most recent action, the Office does not appear to have responded to Applicant's argument regarding this claim. Nevertheless, it still remains that Bibayan instructs that once a *user selects* the folder icon, a new folder window is called to the foreground and its context is registered. (See, e.g. column 4, lines 49-50). Bibayan embellishes upon this example in column 4, starting at line 56. Specifically, Bibayan instructs that "upon [the user] selecting the folder applet" the applet for that function is downloaded from a file server. Bibayan next instructs that the context of the applet is registered with a context manager 21. Bibayan now instructs that dynamic tool palette applet 24 examines the registered context and based thereon, determines whether to modify its tool display. (See, e.g. column 4, line 66-67 through column 5, line 5). The applet for the user-selected function would not have been downloaded from the file server and the subsequent processing would not have taken place *but for the user's selection of the folder icon or applet.* Hence, this claim is not anticipated by Bibayan and, in point of fact, Bibayan teaches directly away from the subject matter of this claim. Accordingly, for at least this reason, this claim is allowable.

Claims 47-59 depend from claim 46 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited

1 features which, in combination with those recited in claim 46, are neither disclosed  
2 nor suggested in the references of record, either singly or in combination with one  
3 another. In addition, given the allowability of claim 46, the rejections of claims  
4 49, 56 and 57 over the combination with Meyer; of claim 55 over the combination  
5 with Gayraud; and of claim 58 over the combination with Powers is not seen to  
6 add anything of significance.

7 **Claim 69** recites a computing system comprising [emphasis added]:

- 8
- 9 • a single application program configured to provide:
  - 10 • a single navigable window;
  - 11 • multiple different functionalities to which the single navigable  
window can be navigated by a user; and
  - 12 • at least *one context-sensitive command area that is associated with*  
*the single navigable window*, the single application program being  
13 configured to automatically *change command sets that are*  
*presented to the user within the command area* as the user  
14 navigates to different functionalities, *at least some commands of the*  
*command sets being displayable independent of the user selecting*  
*any displayed menu item.*
- 15

16 In making out the rejection of this claim, the Office argues that Baer  
17 discloses the subject matter of this claim, except for a context-sensitive command  
18 area or a single application program configured to automatically change command  
19 sets that are presented to the user, or that commands are displayed independent of  
20 the user selecting a displayed menu item. The Office then relies on Meyer and  
21 argues that it supplies the missing elements. Based on these two references, the  
22 Office argues that the subject matter of this claim would be obvious. Applicant  
23 disagrees with the Office's characterization of the references and application of  
24 the references to the subject matter of this claim.  
25

In the previous response, Applicant explained that column 21, lines 65 through column 22, line 11, of Meyer states that “[c]ustom buttons may be volatile, i.e. appearing only in a specific context...”, but does not disclose, suggest or in any way imply that such display is *independent of the user selecting any displayed menu item*. In response, the Office argues that this excerpt teaches that these volatile buttons are linked to a specific window or sub window that is visible and “no where states that it is *dependent* on a selection of a menu item.”

Applicant respectfully but strongly disagrees that Meyer “no where states that it is dependent on a selection of a menu item.” Specifically, column 5, lines 29-32, of Meyer expressly indicates that “a tool board custom control allows a user to navigate through windows and menus in the application by simply *clicking buttons on a tool bar.*” This makes it clear that a specific window or sub window that is visible is *dependent* on a selection of a menu item

As an aside, Applicant respectfully reminds the Office that it bears the initial burden of establishing a *prima facie* case of obviousness. (MPEP 2142). In this regard, to establish *prima facie* obviousness, “all the claim limitations must be taught or suggested by the prior art.” (MPEP 2143.03). Accordingly, it is only what Meyer *teaches*, not what it *does not teach*, that is relevant to establishing *prima facie* obviousness. Therefore, the Office’s reliance on what Meyer *does not teach* is misplaced.

Furthermore, modifying Baer with the teachings of Meyer would fail to result in a *context-sensitive command area that is associated with the single navigable window*, the single application program being configured to automatically *change command sets that are presented to the user within the command area*. Specifically, the Office acknowledges that the volatile buttons in

1 Meyer "are linked to a specific window or sub window that is visible. (Office  
2 Action page 24). In fact, Meyer states that these buttons are "visible only when  
3 the buttons for that particular window are visible." (Column 22, lines 58-59).  
4 Thus, within the same window, the volatile buttons in Meyer cannot change -  
5 making it seemingly impossible to *change command sets that are presented to*  
6 *the user within the command area*, as claimed. The teachings of Baer, in this  
7 regard, are of no avail because it does not even discuss context-sensitive  
8 commands.

9 Finally, Meyer appears to directly teach-away from a *context-sensitive*  
10 *command area that is associated with the single navigable window* in so far as  
11 column 22, lines 58-59, states that the volatile buttons are "visible only when the  
12 buttons for that particular window are visible." Thus, Applicant is hard pressed to  
13 imagine any motivation for combining Baer with Meyer - which teaches away  
14 from the subject matter of this claim.

15 In view of the above discussion, the Office has not established a *prima*  
16 *facie* case of obviousness. Hence, for at least this reason, this claim is allowable.

17 Claims 70-73 depend from claim 69 and are allowable as depending from  
18 an allowable base claim. These claims are also allowable for their own recited  
19 features which, in combination with those recited in claim 69, are neither disclosed  
20 nor suggested in the references of record, either singly or in combination with one  
21 another.

22 **Claim 74** recites a computing system comprising:

- 23
- 24 • a single application program configured to:
- 25

- 1     ○ display a single navigable window for a user to use in  
2         navigating between multiple different functionalities that can  
3         be provided by the single application program;
- 4     ○ provide at least one context-sensitive command area that is  
5         associated with the single navigable window, the single  
6         application program automatically *changing command sets*  
7         *that are presented to the user within the command area* as  
8         the user navigates to different functionalities, at least some  
9         commands of the command sets being displayable  
10         *independent of the user selecting any displayed menu item*;  
11         and  
12     ○ incorporate different functionalities in an extensible manner  
13         so that the user can use the single navigable window to  
14         navigate to the different incorporated functionalities.

10              In making out the rejection of this claim, the Office argues that its subject  
11         matter is obvious in view of Baer and Meyer. Applicant respectfully disagrees.  
12         As noted above, Meyer does not disclose commands that are displayable  
13         *independent of the user selecting any displayed menu item*. Furthermore, it  
14         appears *changing command sets that are presented to the user within the*  
15         *command area*, as claimed, is not possible by modifying Baer with Meyer.  
16         Finally, there would not have been any motivation to combine these references.

17              In view of the above discussion, the Office has not established a *prima*  
18         *facie* case of obviousness. Hence, for at least this reason, this claim is allowable.

19              Claims 75-77 depend from claim 74 and are allowable as depending from  
20         an allowable base claim. These claims are also allowable for their own recited  
21         features which, in combination with those recited in claim 74, are neither disclosed  
22         nor suggested in the references of record, either singly or in combination with one  
23         another.

24              **Claim 78 recites a computing method comprising:**

25

- 1     • displaying a user interface that comprises *a single navigable window*  
2        *that can be navigated between multiple different functionalities*  
3        that are provided by a single application program;
- 4     • receiving user input that indicates selection of a particular  
5        functionality;
- 6     • responsive to receiving said user input, navigating the single  
7        navigable window to the particular selected functionality and  
8        displaying in said window indicia of said functionality that can  
9        enable a user to accomplish a task associated with the particular  
10      selected functionality;
- 11    • determining a user's context within the selected functionality; and
- 12    • automatically displaying at least one command for the user based on  
13      the user's context *independent of the user selecting any displayed*  
14      *menu item.*

15           In making out the rejection of this claim, the Office argues that its subject  
16      matter is obvious in view of Baer and Meyer. Applicant respectfully disagrees.  
17      As noted above, Meyer does not disclose commands that are displayable  
18      *independent of the user selecting any displayed menu item.* Furthermore, it does  
19      not appear to be possible to display a user interface that comprises *a single*  
20      *navigable window that can be navigated between multiple different*  
21      *functionalities*, as claimed, by modifying Baer with Meyer. Finally, there would  
22      not have been any motivation to combine these references.

23           In view of the above discussion, the Office has not established a *prima*  
24      *facie* case of obviousness. Hence, for at least this reason, this claim is allowable.

25           Claim 79 depends from claim 78 and is allowable as depending from an  
26      allowable base claim. This claim is also allowable for its own recited features  
27      which, in combination with those recited in claim 78, are neither disclosed nor  
28      suggested in the references of record, either singly or in combination with one  
29      another.

1           **Claim 80 recites a method of exposing commands in a software application**  
 2           **program comprising:**

- 3           • determining a user's context within an application program *by ascertaining a user's selection within a document* provided by the  
 4           application program; and
- 5           • automatically displaying at least one command on a display for the  
 6           user based on the user's context.

7  
 8           In making out the rejection of this claim, the Office argues that Bibayan  
 9           anticipates the subject matter of this claim. Specifically, the Office argues that  
 10          Bibayan discloses determining the user's context by ascertaining the position of  
 11          the user's cursor *within a document* provided by the application, citing to column  
 12          4, lines 40-44 in support thereof. *This is simply not the case.* Applicant  
 13          respectfully disagrees and traverses the Office's rejection.

14          In the previous response, Applicant explained that Bibayan discloses that  
 15          the user's context is determined by ascertaining which *icon* a user clicks on. (See,  
 16          e.g. column 4, lines 45-55 where the "user selects folder icon 23..." to provide a  
 17          context that is used to drive the display in the dynamic tool palette). The icon that  
 18          the user clicks on in Bibayan cannot be considered a "*document*" as that term is  
 19          utilized in Applicant's Specification. Rather, the icon is more appropriately  
 20          considered as a menu item.

21          As an example of subject matter that embodies the spirit of this claim, the  
 22          Office was referred to the Specification starting on page 12, line 24 through page  
 23          14, line 13, the entirety of which was reproduced in Applicant's response filed  
 24          March 8, 2004. In the previous response, Applicant noted that, in this excerpt  
 25          from the Specification, the described shortcomings of past systems appear to be

1 very characteristic of Bibayan's system, and not characteristic of the presently  
2 claimed subject matter. Applicant disagreed that Bibayan discloses or suggests  
3 "*determining a user's context within an application program by ascertaining a*  
4 *position of a user's cursor within a document provided by the application*  
5 *program.*"

6 In response to Applicant's argument, the Office states "the features upon  
7 which applicant relies (i.e., user context ascertained by the position of the user's  
8 cursor) are not recited in the rejected claim(s)." Applicant respectfully submits  
9 that this statement is misplaced because these features *are* recited in the rejected  
10 claim(s). Specifically, in Applicant's previous response, Applicant explained that  
11 Bibayan discloses that the user's context is determined by ascertaining which *icon*  
12 a user clicks on and that this icon cannot be considered a "*document*" as that term  
13 is utilized in Applicant's Specification. Applicant then referred to the  
14 specification as an example of subject matter that embodies the spirit of this claim.  
15 Nevertheless, Applicant *specifically disagreed* with the Office's argument that  
16 Bibayan discloses or suggests "*determining a user's context within an application*  
17 *program by ascertaining a position of a user's cursor within a document provided*  
18 *by the application program.* In this regard, this claim (claim 80) *indeed recites:*  
19 "*determining a user's context within an application program by ascertaining a*  
20 *user's selection within a document provided by the application program.*"

21 Accordingly, despite the Office's response, Bibayan neither discloses nor  
22 suggests the subject matter of this claim. Therefore, this claim is allowable.

23 Claims 81-87 depend from claim 80 and are allowable as depending from  
24 an allowable base claim. These claims are also allowable for their own recited  
25 features which, in combination with those recited in claim 80, are neither disclosed

nor suggested in the references of record, either singly or in combination with one another. Given the allowability of claim 80, the Office's rejection of claims 82, 83 over the combination with Meyer is not seen to add anything of significance.

Claim 88 recites a method of exposing commands in a software application program comprising:

- *determining a user's context within an application program; and*
- automatically displaying at least one command on a display for the user based on the user's context, *independent of a user selecting any displayed menu item.*

In making out the rejection of this claim, the Office argues that Bibayan anticipates the claim's subject matter and in so doing, uses language that does not appear in the claim. Applicant believes this to be an oversight. Nonetheless, in the previous response Applicant argued that Bibayan neither discloses nor suggests automatically displaying at least one command on a display for the user based on the user's context, *independent of a user selecting any displayed menu item.*

In response to Applicant's argument, the Office argues that the excerpt discussed above (column 4, lines 45-65) in which the user selects a folder icon from the static toolbar is merely a "specific example of the invention as claimed." The Office additionally cites to column 9, lines 30-40, of Bibayan and states "the dynamic tool palette having tool functions specified by 'examining the specified context environment of the currently executing application program...'"'. The Office argues, however, that "this is a specific example and that context can be evaluated from a window not prompted from the static toolbar." Finally, the

1 Office further cites column 1, lines 55-61, of Bibayan and argues "when one  
2 window yields focus to another this would be a method of changing context."

3 As described above, despite the Office's response, Bibayan does not  
4 disclose or suggest determining a user's context within an application program and  
5 automatically displaying a command independent of a user selecting any displayed  
6 menu item and, in point of fact, teaches directly away therefrom. Accordingly, the  
7 Office has not established a *prima facie* case of obviousness and this claim is  
8 allowable.

9 Claims 89-94 depend from claim 88 and are allowable as depending from  
10 an allowable base claim. These claims are also allowable for their own recited  
11 features which, in combination with those recited in claim 88, are neither disclosed  
12 nor suggested in the references of record, either singly or in combination with one  
13 another. In addition, given the allowability of claim 88, the Office's rejection of  
14 claims 90 and 91 over the combination with Meyer is not seen to add anything of  
15 significance.

16 **Conclusion**

17 Applicant respectfully submits that all of the claims are in condition for  
18 allowance and Applicant respectfully requests a Notice of Allowability be issued  
19 forthwith. If the next anticipated action is to be anything other than issuance of a  
20 Notice of Allowability, Applicant respectfully requests a telephone call for the  
21 purpose of scheduling an interview.  
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Dated: 5/20/05

Respectfully Submitted,

By:



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